

Sipos, John

From: Cooke, Colleen
Sent: Thursday, January 11, 2007 1:27 PM
To: Sipos, John
Cc: Rada, Rinaldi
Subject: 3721 Reissue 09/512,734 due back no later than 2/8 to 8A35

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Due By: Thursday, February 01, 2007 8:00 AM
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John:

This reissue is not yet ready for allowance. I am returning this reissue back to you via your SPE's mailbox in order to make the following corrections:

- The consent of assignees and statement under 3.73(b) by the assignee do not reflect the **chain of title** of the original patent. I have enclosed for your reference a printout of the chain of title from PALM and a copy of the current filed 3.73b statement to illustrate the information missing; basically, the application neglected to fill in the rest of the form they submitted. With respect to the consent, it needs to reflect the consent of the *current* assignee.
- There is no indication that a litigation search has been performed. Please contact the STIC and have them perform a search. Include the search with your office action
- The oath/dec filed 3/2/06 is defective and could be rejected using form paragraphs 6.05, 6.05.07 as well as 14.01.01. The corresponding problems are:

6.05.07: language required by 37 CFR 1.63 b(3): "(b)(3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to **patentability** as defined in § 1.56." The oath filed 3/2/06 lacks this statement entirely; I highlighted portions above which you should be check in any supplemental oath the applicant submits as it is frequently wrong.

14.01.01: The error statements that the applicant has submitted thus far are to the effect of "the omission of broader claims to ____", "failing to recite certain features, including ____", "failing to claim the feature of ____". None of these are sufficient to properly specifically identify the error. Please also refer to MPEP 1414, the most relevant portion of which states:

(C) It is not sufficient for an oath /declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure." Rather, the oath /declaration must specifically identify an error. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987). **Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. A statement of " ... failure to include a claim directed to ..." and then presenting a newly added claim, would not be considered a sufficient " error" statement** since applicant has not pointed out what the other claims lacked that the newly added claim has, or vice versa. Such a statement would be no better than saying in the reissue oath or declaration that " this application is being filed to correct errors in the patent which may be noted from the change made by adding new claim 10." In both cases, the error has not been identified.

The best thing to do in trying to guide the applicants on crafting the specific statement of error, besides referring them to the above portion of the MPEP, is to keep in mind that a reissue is filed to correct and error that makes the patent inoperative or invalid. A statement of failure to include claims to something or a certain limitation (especially when the limitation is not added to the original patent claims but is submitted as a separate claim) doesn't really get at how the original claims are in error (inoperative or invalid). Merely neglecting to have extra claims or limitations in the original patent doesn't make it inoperative or invalid. Also keep in mind that the MPEP does make it clear that the statement should identify the error by reference to the specific claim(s) and the specific language wherein lies the error. In this case, no reference to any specific claim is made and that is part of the problem.

- The IDS you have included in the red folder along with your Allowance is two pages; the first page appears to have inadvertently not been filled in. The patent numbers on the first page, but none of the other info has been filled in. It is likely you might have forgotten to click the "fill" button when filling out the first page in OACS and instead went on to the second page. Just be sure the next IDS you prepare has that info filled in.
- Lastly, I noted that in addition to the amendment of 3/2/06 in eDAN, you have an additional faxed-in amendment. I'm not sure what the reason for that was or how it differed from that of 3/2/06. I did have a minor concern that because the pages you printed it on have printing on the back side, it might not scan in clearly. I haven't sent papers like that to scanning so I don't know; maybe you have and do. As long as it scans cleanly it is ok otherwise you will have to reprint it.

When completed, please return the case to my office (RAN-8A35). **The corrections must be back to me (in 8A35) within 4 weeks, on 2/8/07, otherwise the allowance will be automatically withdrawn.** Also, please include a copy of this email on the face to further expedite my final review of this case.

If you have any questions, feel free to contact me.

Thanks!!

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TC 3700
RAN 8A35
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